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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,671	08/29/2003	Hugh S. West JR.	14000.8.1	9319
7590	12/23/2005		EXAMINER	
John M. Guynn WORKMAN, NYDEGGER & SEELEY 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111			KIM, JOHN	
			ART UNIT	PAPER NUMBER
			3733	
			DATE MAILED: 12/23/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/651,671	WEST ET AL.
Examiner	Art Unit	
John Kim	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 December 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 11-16 is/are rejected.
- 7) Claim(s) 10 and 17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 August 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/1/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election **without** traverse of invention I (claims 1-17) in the reply filed on 12/7/05 is acknowledged.

Claims 18-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/7/05.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4, 6-9, 11, 20 and 21 of U.S. Patent No. 6679889 in view of Neufeld (US Pat 3842824).

The difference between the application claims and the patent claims lies in the fact that the patent claims in regard to the tensioning device include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims. However, the patent fails to include guide pins with the feature of notches or grooves. Neufeld teaches of having guide pins (10) that are notched. Thus it would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Goble in view of Neufeld in order to have guide pins that are easy to break to the desired length.

Claims 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6679889 in view of Jain (US Pat 5207703).

In regards to claim 1 of the patent and the application, the difference between the application claims and the patent claims lies in the fact that the patent claims include

more elements in regards to the tensioning device and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims. However, the patent fails to teach about the suture separator. Jain teaches of having a separator that can maintain at least two sutures in a space apart relationship. Thus it would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Goble in view of Jain in order to separate the sutures from a multi-strand tissue graft.

Regarding claim 12, Jain teaches of having a separator with a gripping head (either end of the device in figure 7) and a chiseled end (opposite end of the gripping head).

Regarding claim 13, Jain teaches of having a separator with a first recess (59) and a second recess (any of the other 59's).

Regarding claim 14, Jain teaches of having a separator having a pair of guide recess (any two 59's that will mate with the attachment post of the tensioning device of Goble).

Regarding claim 15, Jain teaches of having two separators that can separate four suture strands.

Regarding claim 16, two separators, as taught by Jain, can be placed where the "retaining members" (55) of both separators face each other, the space between the two separators can be considered as the central recess.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al (US Pat 5713897 in IDS) in view of Neufeld (US Pat 3842824).

Regarding claim 1, Goble teaches a tensioning system comprising guide pins (18), a tensioning device with an attachment portion (24 and 27), attachment posts (24), a tensioning portion with an adjustable tensioning apparatus (the rest of the apparatus in figure 1). Though Goble fails to teach to have more than one adjustable tensioning apparatus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the invention of Goble having a plurality of adjustable tensioning apparatus, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Also, Goble fails to teach of having guide pins that are notched or grooved. Neufeld teaches of having guide pins (10) that are notched, which helps the surgeon to break the pins to a desired length. Thus it would have been

obvious to one skilled in the art at the time the invention was made to construct the invention of Goble in view of Neufeld in order to have guide pins that are easy to break to the desired length.

Regarding claim 2, Goble teaches that the pins can be used once and discarded.  
(col 9:58-60)

Regarding claim 3, Goble teaches that the attachment post (24) are hallow and slidably received one of the guide pins. (see fig 3, 3a, 4)

Regarding claim 7, Goble teaches of having a tensile load gauges (61) that displays the tensile load (col 8:11-17). "Fig 4 shows the slide broad head groove 58a aligned with the marking identified as eight to indicated that eight pounds of tensile stress is being applied to the suture."

Regarding claim 8, Goble teaches that his invention has an attachment portion and tensioning portion that are non-removably joined together.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al (US Pat 5713897 in IDS) in view of Neufeld (US Pat 3842824).as applied to claims 1-3, 7, and 8 above, and further in view of Jain (US Pat 5207703).

Regarding claim 9, Goble and Neufeld teaches of a tensioning system with notched guide pins, but fail to include a suture separator. Jain teaches of a suture separator, possibly being attached to the tensioning device and can maintain at least two sutures. Thus it would have been obvious to one skilled in the art at the time the

invention was made to construct the invention of Goble in view of Neufeld and further in view of Jain in order to separate the sutures from a multi-strand tissue graft.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al (US Pat 5713897 in IDS) in view of Jain (US Pat 5207703).

Regarding claim 11, Goble teaches of having a tensioning device with an attachment portion (24 and 27) and a tensioning portion (the rest of the apparatus of figure 1). As mentioned above, Goble fails to teach to have more than one adjustable tensioning apparatus. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the invention of Goble having a plurality of adjustable tensioning apparatus, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Also, Goble fails to teach about a suture separator. Jain teaches of having a separator that can maintain at least two sutures in a space apart relationship. Thus it would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Goble in view of Jain in order to separate the sutures from a multi-strand tissue graft.

Regarding claim 12, Jain teaches of having a separator with a gripping head (either end of the device in figure 7) and a chiseled end (opposite end of the gripping head).

Regarding claim 13, Jain teaches of having a separator with a first recess (59) and a second recess (any of the other 59's).

Regarding claim 14, Jain teaches of having a separator having a pair of guide recess (any two 59's that will mate with the attachment post of the tensioning device of Goble).

Regarding claim 15, Jain teaches of having two separators that can separate four suture strands.

Regarding claim 16, two separators, as taught by Jain, can be placed where the "retaining members" (55) of both separators face each other, the space between the two separators can be considered as the central recess.

***Allowable Subject Matter***

Claims 10 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 

  
CORRINE McDERMOTT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700